

### **REMARKS**

Applicants respectfully request reconsideration in view of the amendment and the following remarks. Support for amended claim 1 can be found in the original claim 12 and specification, page 6, lines 22-23. The applicant has amended claim 10 as suggested by the Examiner. No new matter has been added.

Claim 10 is rejected under 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-18 are rejected under 35 U.S.C. 102(b), as being anticipated by Lorenz et al. (US 5,646,290) ("Lorenz"). The applicant respectfully traverses these rejections.

#### **Rejection of Claim 10**

Claim 10 is rejected under 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has amended claim 10 as suggested by the Examiner. For the above reasons, this rejection should be withdrawn.

#### **Rejection Over Lorenz**

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lorenz. Lorenz is cited at the specification at page 2, line 18. Lorenz does not teach using organic solvents as is required by the applicant's claimed invention. For this reason alone this rejection should be withdrawn.

Furthermore, the applicant believes that the preamble, "an aqueous printing ink for textile printing by the inkjet process" should be given patentable weight. Terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) ([A] preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim.). Although no "litmus test" exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to

determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. *Id.* (citing *Corning Glass Works v. Sumitomo Electric USA, Inc.*, 868 F.2d 1252, 1257 (Fed. Cir. 1989). Accordingly, the PTO has allowed preamble language to be relied upon to distinguish an invention from the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1347-48 (Fed. Cir. 2002). Read in light of the specification, the claims of the present application an aqueous printing ink for textile printing by the inkjet process and not used for a dyeing of hydrophobic synthetic materials as does Lorenz.

Furthermore, applicant's specification indicates that the claims are directed at an aqueous printing ink for textile printing by the inkjet process specifically. Addressing facts very similar to those herein, the Federal Circuit held that where the preamble recites additional structure or steps that the specification deems important, the preamble may limit the claims. *See Corning Glass*, 868 F.2d at 1257. In *Corning Glass* the claim in question read: "An optical wave guide comprising..." The specification later went on to define "optical wave guide." The court held that the preamble limited the claim to optical wave guides because "optical wave guide" was later defined in the specification. *Id.*

Similarly, the present invention's specification defines and describes the characteristics of an aqueous printing ink for textile printing by the inkjet process. The applicant believes that this limitation is very important as it tells the person of ordinary skill in the art that the claimed subject matter is not just an aqueous suspension as disclosed in Lorenz. In fact a printing ink for the inkjet process must fulfill several preconditions in order to be able to properly pass the inkjet nozzle without polluting and clogging it, see specification, page 1, line 35 to page 2, line 7. The person of ordinary skill in the art is aware of that and knows that the aqueous suspension of the reference is not an ink and can't be used as an ink.

It is clear that the definition and characteristics of an aqueous printing ink for textile printing by the inkjet process is important to an understanding of what was claimed and as a result the preamble should be given weight.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13077-00092-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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